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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,756	04/08/2005	Karla Araujo	033794/280375	6840
826	7590	11/12/2008	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			FRAZIER, BARBARA S	
			ART UNIT	PAPER NUMBER
			1611	
			MAIL DATE	DELIVERY MODE
			11/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,756	Applicant(s) ARAUJO ET AL.	
	Examiner BARBARA FRAZIER	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawal of Finality of previous Office Action

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Status of Claims

2. Claims 1, 2, 4, and 8-15 are pending in this application.
3. Claims 1, 2, 4, and 8-15 are examined.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1, 4, 8, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach et al (US Patent 5,980,871). The rejection of claim 2 over Lukenbach et al has been withdrawn.**

The claimed invention is drawn to an oily dispersion of pigments comprising zinc oxide and titanium dioxide added in the form of a powder to a single oily base in the amounts specified in claim 1, and further comprising a single emollient vehicle (see claim 1).

Lukenbach et al. disclose sunscreen compositions comprising an inorganic sunscreen compound, such as a mixture of titanium dioxide and zinc oxide, in an oil

Art Unit: 1611

component comprising a carrier oil and at least one emollient (see col. 4, lines 28-37).

The inorganic sunscreen compound is oil dispersible (col. 6, lines 34-36), and is added to the oil phase (col. 7, lines 30-34). The amount of titanium dioxide present in the composition is from about 2% to about 25% (col. 6, lines 27-30), and 5% zinc oxide is exemplified (Example 96, col. 13, lines 13-15).

Lukenbach et al do not teach a concentration of titanium dioxide from 30% to 35% by weight.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to adjust the amount of titanium dioxide to 30%; thus arriving at the claimed invention. One skilled in the art would have been motivated to do so because Lukenbach et al's teaching of the amount "about 25%" is comparable to Applicant's teaching of the amount of 30%, especially given that the prior art uses the flexible modifier "about". It would have been obvious to determine workable and/or optimal amounts of pigment per the reasoning of well-established precedent, such as In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235(CCPA 1955). (Holding that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.")

Regarding claim 4, Lukenbach et al. teach that titanium dioxide is present in the final composition in an amount of about 2% to about 25% (col. 6, lines 29-30) and that zinc oxide is present in an amount of 5% by weight (col. 13, lines 14-15). This appears to be comparable to the amounts claimed by Applicants, especially given that the prior art uses the flexible modifier "about". In any case, it would have been obvious to

Art Unit: 1611

determine workable and/or optimal amounts of pigment per the reasoning of well-established precedent, such as In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235(CCPA 1955). (Holding that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”)

Regarding claim 8, Lukenbach et al. teach that zinc oxide is present at 5% (Example 96, col. 13, lines 13-15). This is encompassed by Applicant’s amount of 5 to 10%.

Regarding claim 13, Lukenbach et al. teach that the emollient should be present in the formulation in a ratio to the carrier concentration of from about 1:1 to about 3:1, most preferably about 2:1. This appears to be comparable to the amounts claimed by Applicants, i.e., where the weight percentage **within the oily dispersion** is 45-65%, especially given that the prior art uses the flexible modifier “about”. In any case, it would have been obvious to determine workable and/or optimal amounts of emollient per the reasoning of well-established precedent, such as In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). (Holding that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”)

Regarding claim 14, Lukenbach et al teach the concurrent addition of the oil and emollient, followed by addition of titanium dioxide (see col. 7, lines 44-53). Lukenbach et al teach that both titanium dioxide and a mixture of titanium dioxide and zinc oxide are examples of the “inorganic sunscreen agent”. Therefore, a person having ordinary

Art Unit: 1611

skill in the art at the time the invention was made would have been motivated to substitute the mixture of titanium dioxide and zinc oxide for the titanium dioxide in the process outlined in Lukenbach et al, with a reasonable expectation of success.

Regarding claim 15, Lukenbach et al teach that "The compositions of this invention can be incorporated into various cosmetic and personal care products such as hand and body lotions, oils, ointments, lip balm products, facial cosmetics and the like" (col. 7, lines 11-15).

Response to Arguments

3. Applicant's arguments filed 10/15/08 have been fully considered but they are not persuasive.

Applicants argue that the recitation "about 25%" does not encompass the recited 30% (in claim 1 of the claimed invention). Applicants argue that the percent difference between 25 TiO₂ and 30 percent TiO₂ is on the order of 20% (18.2%), and one of ordinary skill in the art would not interpret the term "about" to be so expansive.

This argument is not persuasive because one skilled in the art would be motivated to manipulate the amount of TiO₂ within a reasonable range of "about 25%" in order to optimize the sunscreen properties of the resultant composition. A weight percent difference of 5% (from 25% to 30%) is considered to be reasonable and fall within the range of "about".

Applicants also argue that the term "about as used in the specification of Lukenbach should be limited to 25 % or less, and should not be interpreted to disclose or suggest a range approaching 30% or greater.

Art Unit: 1611

This argument is not persuasive because Lukenbach specifically teaches that its instant sunscreen compositions may contain amounts of sunscreen of "about 25%", which reasonably reads on 30%. Applicant's assertions that the teaching of Lukenbach wherein the amount of titanium dioxide is "even up to 15% with acceptable appearance, or possibly higher" is not conclusive that anything above said range are "pure speculation".

In response to Applicant's arguments that the examples of Lukenbach do not teach amounts of titanium dioxide approaching 25%, it is noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach et al (US patent 5,980,871) in further view of Choulot et al (US 2004/0191189).

Claim 9 of the claimed invention is drawn to an oily dispersion of pigments for protection against UV radiation, characterized by comprising, in a single oily base, zinc oxide and titanium dioxide added in the form of a powder, wherein the two pigments are dispersed in a single oily dispersing vehicle and the dispersion further comprises a single emollient vehicle, and wherein the particle size of the TiO₂ and ZnO pigments used ranges from 15 to 100 nanometers.

Lukenbach et al. teach that titanium dioxide should be used having a primary particle size from of less than about 300 nm in diameter (col. 6, lines 27-29).

Art Unit: 1611

Choulot et al. teach that it is known to use a mixture of titanium dioxide and zinc oxide with a mean particle size being between 1 and 100 nanometers in a sunscreen composition (page 1, paragraph 4).

Lukenbach et al. differ from the claimed invention in claim 9 because the reference is silent with respect to whether or not the mixture of titanium dioxide and zinc oxide is in particulate form (i.e., from 15 to 100 nanometers).

However, since Choulot et al. teach that it is known to use a mixture of titanium dioxide and zinc oxide with a mean particle size being between 1 and 100 nanometers in a sunscreen composition (page 1, paragraph 4), and since both compositions are sunscreen compositions, a person having ordinary skill in the art at the time the invention was made would have been motivated to use a mixture of titanium dioxide and zinc oxide with the size of Choulot et al. in the sunscreen composition of Lukenbach et al., with a reasonable expectation of success.

Response to Arguments

Applicants have not argued the merits of the instant rejection separately from the rejection of claims 1, 4, 8, and 13-15 over Lukenbach et al (US Patent 5,980,871).

Accordingly, claim 9 stands rejected for reasons stated above.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach et al (US Patent 5,980,871) in further view of Kaplan (US Patent 5,989,529).

Art Unit: 1611

Claims 10 and 11 of the claimed invention are drawn to an oily dispersion of pigments for protection against UV radiation, characterized by comprising, in a single oily base, zinc oxide and titanium dioxide added in the form of a powder, wherein the two pigments are dispersed in a single oily dispersing vehicle and the dispersion further comprises a single emollient vehicle, and wherein the dispersing vehicle is selected from the group consisting of polyethyleneglycol and silicone esters, particularly dipolyhydroxy stearate PEG 30.

Lukenbach et al. teach that the carrier oil should be selected from the group of polyether interrupted fatty acid esters (col. 5, lines 65-66).

Kaplan teaches that PEG 30 dipolyhydroxystearate may be advantageously used to permit the formulation of “an improved oil-in-water sunscreen formulation having improved stability, low viscosity and cosmetic elegance.” (col. 1, lines 40-46).

Lukenbach et al. differ from the claimed invention in claims 10 and 11 because they do not specifically teach that the oil is polyethyleneglycol esters or dipolyhydroxy stearate PEG 30.

However, since Kaplan teaches that PEG 30 dipolyhydroxystearate may be advantageously used to permit the formulation of “an improved oil-in-water sunscreen formulation having improved stability, low viscosity and cosmetic elegance”, and since both compositions are drawn to sunscreen formulations, a person having ordinary skill in the art at the time the invention was made would have been motivated to choose dipolyhydroxy stearate PEG 30 as the oil in the sunscreen composition of Lukenbach et al., with a reasonable expectation of success.

Response to Arguments

Applicants have not argued the merits of the instant rejection separately from the rejection of claims 1, 4, 8, and 13-15 over Lukenbach et al (US Patent 5,980,871). Accordingly, claims 10 and 11 stand rejected for reasons stated above.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach et al (US Patent 5,980,871) in further view of Liu et al (US Patent 5,916,544).

The instant invention is drawn to an oily dispersion of pigments for protection against UV radiation, characterized by comprising, in a single oily base, zinc oxide and titanium dioxide added in the form of a powder, wherein the two pigments are dispersed in a single oily dispersing vehicle and the dispersion further comprises a single emollient vehicle, and wherein the emollient is selected from the group consisting of isocetyl stearoyl stearate, glycerol tri-2-ethyl hexanoate and propoxylated stearyl alcohol.

Lukenbach et al. teach that the emollient may be “a conventional emollient known to those of ordinary skill in the art as useful in sunscreen products, such as...synthetic emollients such as fatty acid esters and the like” (see col. 6, lines 14-19).

Liu et al. teach that Ceraphyl 791 (isocetyl stearoyl stearate) is known to be used as an emollient in sunscreen compositions with titanium dioxide and zinc oxide (for example, see Examples 18 and 19, col. 6, lines 63-64 and col. 8, lines 20-21).

Lukenbach et al. differ from the claimed invention in claim 12 because they do not specifically teach that the emollient is isocetyl stearoyl stearate, glycerol tri-2-ethyl hexanoate, or propoxylated stearyl alcohol.

However, since Liu et al. teach that Ceraphyl 791 (isocetyl stearoyl stearate) is known to be used as an emollient in sunscreen compositions with titanium dioxide and zinc oxide, and since both compositions are sunscreen compositions, a person having ordinary skill in the art at the time the invention was made would have been motivated to choose isocetyl stearoyl stearate as the fatty acid ester emollient in the composition of Lukenbach, with a reasonable expectation of success.

Response to Arguments

Applicants have not argued the merits of the instant rejection separately from the rejection of claims 1, 4, 8, and 13-15 over Lukenbach et al (US Patent 5,980,871). Accordingly, claim 12 stands rejected for reasons stated above.

7. Claims 1, 2, 4, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez et al (US Patent 6,440,402) in view of SaNogueira et al (US Patent 6,830,746) and Cole et al (US Patent 5,340,567).

The claimed invention is delineated above (see paragraph 2).

Gonzalez et al teach sunscreen compositions wherein the sunscreen agents may be a combination of known sunscreens, including titanium dioxide and zinc oxide (col. 2, lines 31-51). The sunscreen actives may be present at up to about 70 wt %, preferably up to about 50 wt % (col. 2, lines 53-56). Suitable vehicles for the sunscreen agents

Art Unit: 1611

include oils (col. 3, lines 63-65). The composition may further include emollients (col. 4, lines 42).

Gonzalez et al do not specifically teach the combination of titanium dioxide and zinc oxide in the amounts specified by claim 1.

SaNogueira et al teach that higher amounts of sunscreen agents, including combinations of titanium dioxide and zinc oxide, result in higher SPF values (col. 2, lines 33-62).

Cole et al teach that, when titanium dioxide and zinc oxide are used in a preferable weight ratio of 1:8 to 3:1, they act as a synergistic combination with respect to SPF values (col. 4, lines 62-66).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use titanium dioxide and zinc oxide in amounts specified in claim 1 of the claimed invention in the composition taught by Gonzalez et al; thus arriving at the claimed invention. One skilled in the art would be motivated to do so because higher amounts of sunscreen agents (e.g., where the total amount of sunscreen approaches 50%) result in greater functionality of the sunscreen agents (i.e., higher SPF values) as taught by SaNogueira et al. Furthermore, the weight ratio of 3:1 results in a synergistic combination and therefore is preferred, as taught by Cole et al. Therefore, the amounts of titanium dioxide and zinc oxide would be comparable to or overlap those of the claimed invention, and one skilled in the art would be motivated to select amounts of titanium dioxide and zinc oxide from the preferred ranges by routine experimentation, in order to optimize the SPF values of the resultant composition. One

Art Unit: 1611

would reasonably expect success from the use of titanium dioxide and zinc oxide in the composition taught by Gonzalez et al in higher amounts as taught by SaNogueira et al and preferred weight ratios as taught by Cole et al because all of the references are drawn to sunscreen compositions.

Regarding claim 2, Cole et al teach that the weight ratio of titanium dioxide to zinc oxide of 3:1 results in a synergistic combination with respect to SPF values (see col. 4, lines 63-66).

Regarding claim 4, Gonzalez et al teach that the total concentration of sunscreen agents, including the combination of titanium dioxide and zinc oxide, is preferably 0.05 to 50 wt% (col. 2, lines 53-56). This range encompasses that of the claimed invention, and one skilled in the art would be motivated to select amounts of sunscreen agents from within said range by routine experimentation, in order to optimize the SPF value of the resultant composition.

Regarding claim 8, Gonzalez et al do not specifically teach an amount of zinc oxide in the range of 5 to 10% by weight. However, Cole et al teach that a preferred weight ratio of titanium dioxide to zinc oxide of 3:1 results in a synergistic combination with respect to SPF values, and SaNogueira et al teach that higher amounts of sunscreen agents result in higher SPF values. Therefore, the resultant amount of zinc oxide would be comparable to or overlap that of the claimed invention, and one skilled in the art would be motivated to select amounts of zinc oxide from the preferred ranges by routine experimentation, in order to optimize the SPF values of the resultant composition.

Art Unit: 1611

Regarding claim 15, Gonzalez et al teach that the compositions are topical sunscreen compositions (abstract) and may other cosmetically acceptable ingredients (col. 4, lines 38-49).

Claim Objections

8. Claims 14 and 15 are objected to because they are dependent on canceled claims. Claims 14 and 15, as amended, are dependent on claims 1, 2, 4-7, and 9-13; however, claims 5-7 are canceled. Appropriate correction is required.

9. Claim 8, as amended, is now dependent on claim 1. However, original claim 8 was originally dependent on claim 7 (now canceled), and Applicants have not changed the status of amended claim 8 from "Original" to "Amended". It is suggested Applicants correct the status of the claim to "Amended".

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA FRAZIER whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571)272-0614. The fax phone

Art Unit: 1611

number for the organization where this application or proceeding is assigned is 571-273-8300.

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BSF

/Sharmila Gollamudi Landau/
Supervisory Patent Examiner, Art Unit 1611